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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,279	08/18/2005	Jiri Babej	PZI1948/CIP	2952
40/401 7590 06/08/2010 Hershkovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314				
EXAMINER REESE, DAVID C				
ART UNIT 3677		PAPER NUMBER		
NOTIFICATION DATE 06/08/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@hershkovitz.net
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Office Action Summary

Application No.

10/528,279

Applicant(s)

BABEJ ET AL.

Examiner

DAVID REESE

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 12-13, 34-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 14-33, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/2009 (and 4/13/2010) has been entered. Consequently, the following is the current listing of claims in the instant application:

Status of Claims

- Claims 9, 27, and 30 were amended.
- Claims 1-8, 12-13, 34-35 are withdrawn.
- Claims 1-37 are pending.

Claim Rejections - 35 USC § 103

- [1] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- [2] Claims 9-11, 14-33, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 196090252 C1, in view of Mueller, US-7,160,047.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 9, DE 196090252 C1 teaches of a hollow fastener element [for the electrically conductive attachment of an electrical terminal device (10) to a sheet metal part]*, wherein the hollow fastener element (3) has a head part (31') and a tubular rivet section (31), with the rivet section (31) merging via a contact surface (81) for the sheet metal part into the head part (31'), wherein said head part (31') has an end face remote from said tubular rivet section (31), wherein the hollow fastener element has a bore, [at a point at which a thread is formed by screwing-in a thread cutting or thread forming screw (see fig. 4, the bore 49 ready for insertion of cutting screw of thread) thereby forming an electrically conductive connection between said screw and said element]* and wherein a mount (33) for the rotationally secure attachment of the electrical connection device (10) to the fastener element is provided at the end face of said head part (31').

Examiner's note:* the above statements in brackets are examples of intended use, limitations that fail to further define the structure of the claimed invention. Since the prior art of DE 196090252 is capable of being used to attach an electric device to a sheet metal part; as well as the bore able to have a thread formed by screwing-in a thread cutting or thread forming screw, the examiner maintains that the prior art remains anticipatory in the instant case. The current claim is solely directed to that of the subcombination of the fastener (see underlined language above). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The difference between the claim and DE 196090252 is that DE 196090252 does not expressly state of features at the contact surface and/or rivet section providing security against rotation. Muller discloses a fastener similar to that of DE 196090252. In addition, Muller further teaches of features (38) providing a security against rotation so as to accomplish the same task. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art, having the disclosures of DE 196090252 and Muller before him at the time the invention was made, to modify the functional element taught by DE 196090252 to comprise anti-rotational features as in Muller, in order to prevent the functional element from rotation once joined to the sheet metal part.

Re: Claim 10, wherein the mount (33) is formed by at least one projection (33) projecting beyond the end face of the fastener element.

Re: Claim 11, wherein the fastener element (3) is executed with two projections which are formed by two lugs (33) having a spacing from one another which are arranged to the side of the bore of the hollow fastener element.

Re: Claim 14, wherein the mount (33) is formed by a recess in the end face of a fastener element which merges into one or more radially extending grooves.

Re: Claim 15, wherein a tubular guide section (38) is arranged concentric to the tubular rivet section (31) and radially inside the latter, with a ring gap (between 38 and 31) being provided between the guide section (38) and the rivet section (31) and with the guide section projecting beyond the free end of the rivet section.

Re: Claim 16, wherein the free end of the wall of the tubular rivet section (31) is rounded when viewed in an axial section plane both at the radially outer side and also at the radially inner side.

Re: Claim 17, wherein the ring gap has a radial dimension in the range between 0 mm and approximately 3 mm.

Re: Claim 18, wherein the ring gap finishes at an axial spacing before the contact surface (31) at the rivet section side of the contact surface (31).

Re: Claim 19, wherein the guide section (38) is formed as a piercing section and has a circular cutting edge at its end remote from the contact surface (31).

Re: Claim 20, DE196090252 as modified by Muller teaches wherein features (38) providing security against rotation are disposed at least one of in the region of the contact surface (31): the rivet section and the jacket surface of the head part adjacent to the contact surface.

Re: Claim 21, Muller teaches wherein features (38) providing security against rotation are formed by at least one of noses and grooves.

Re: Claim 22, DE196090252 as modified by Muller teaches wherein noses providing security against rotation are provided and are present in raised form at the contact surface (81) and at the rivet section (31) in the region of the transition from the contact surface to the rivet section.

Re: Claim 23, DE196090252 as modified by Muller teaches wherein said noses providing security against rotation extend in the radial direction at the contact surface (81) and in the axial direction at the rivet section (31).

Re: Claim 24, Muller teaches said features (38) providing security against rotation comprise noses and have one of a generally rounded shape and side flanks which lie in planes extending in the longitudinal direction of the element.

Re: Claim 25, the hollow fastener element has a hollow cylindrical region where the thread forming or cutting screw forms or cuts a thread cylinder said hollow cylindrical region being one of which is provided in the head part (31'), provided or in the guide section (38) and provided or at least partly in the head part (31') and in the guide section (38).

Re: claim 26, wherein said thread cylinder ends in the axial direction approximately at a position where said the gap ends.

Re: Claim 27, wherein said projection is formed by at least one lug and the or each lug (33) has a flank, which, on the attachment of a cable shoe, prevents rotation of the latter about the longitudinal axis of the functional element (3).

Re: Claim 28, wherein, at the position of the or each lug (33) the jacket surface of the head part (31') has a corresponding recess which, on the attachment of the functional element to a sheet metal part (8), serves as a security against rotation.

Re: Claim 29, wherein said rivet section (31) is a piercing and riveting section.

As for Claim 30, DE 196090252 C1 teaches of a component assembly consisting of a sheet metal part (8) and a hollow fastener element (3) attached to it via a rivet connection, wherein the fastener element has a smooth cylinder bore [for receiving a thread forming or cutting screw (see fig. 4, the bore 49 ready for insertion of cutting screw of thread) whereby said thread forming or cutting screw forms or cuts a screw thread into said bore to form an

electrically conductive connection to said hollow fastener element at said bore]* and wherein the fastener element has an end face remote from the rivet connection and a mount (33) at the end face remote from the rivet connection for the rotationally secure attachment of an electrical terminal device (10), [with a head of said thread forming or cutting screw forming an electrically conductive connection to said electrical terminal device thereby establishing an electrical connection from said electrical terminal device to said head of said screw, via said screw to said hollow fastener element via said screw thread and from said hollow fastener element to said sheet metal part].*

Examiner's note:* the above statements in brackets are examples of intended use, limitations that fail to further define the structure of the claimed invention. Since the prior art of DE 196090252 is capable of performing the above functional recitations, the examiner maintains that the prior art remains anticipatory in the instant case. The current claim is solely directed to the assembly of the sheet metal part and a hollow fastener element (see underlined language above). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The difference between the claim and DE 196090252 is that DE 196090252 does not expressly state that wherein the fastener element is rotationally fixedly secured to the sheet metal part by means of features providing security against rotation and the fastener element and the sheet metal part are jointly coated with an electrically non-conductive or poorly conductive protective coating (120) and an electrically conductive path is provided between the fastener

element and the sheet metal part at least at one of in the region of the rivet connection and at the features providing security against rotation. First, with respect to the former limitation above, Muller discloses a fastener similar to that of DE 196090252. In addition, Muller further teaches of features (38) providing a security against rotation so as to accomplish the same task. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art, having the disclosures of DE 196090252 and Muller before him at the time the invention was made, to modify the functional element taught by DE 196090252 to comprise anti-rotational features as in Muller, in order to prevent the functional element from rotation once joined to the sheet metal part.

Second, with respect to the latter limitation above, in addition, Mueller further teaches of providing the fastener assembly with a protective coating such as a paint layer (see col. 3, lines 8-15 and col. 8 lines 1-10). It would have been obvious to one of ordinary skill in the art, having the disclosures of DE 196090252 and Mueller before him at the time the invention was made, to modify the fastening assembly of DE 196090252 to possess a protective coating as in Mueller. One would have been motivated to make such a combination because the use of such a coating, as taught by Mueller, are known in the art of fasteners for their protection, corrosion resistance, resistance to scratching etc, characteristics.

Re: Claim 31, wherein a thread cutting or forming screw is screwed into the hollow fastener element (3) and holds the electrical connection device at the fastener element (3) in the manner secure against rotation.

Re: Claim 32, wherein the mount (33) is formed by at least one projection (33) projecting beyond the end face of the fastener element.

Re: Claim 33, wherein the fastener element is executed with two projections (33) which are formed by two lugs having a spacing from one another which are disposed to the side of the hole of the hollow fastener element.

Re: Claim 36, wherein said mount (33) is formed by a recess in the end face of the fastener element which merges into one or more radially extending grooves.

Re: Claim 37, wherein said free end wall of the rivet section has one of a semi-circular shape and a shape resembling an arrow-tip (see fig. 3a).

Response to Arguments

[3] Applicant's amendments and arguments filed 2/18/2009 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. First, with regard to independent claim 1, the applicant removed the "to be" language. Even with the deletion of this claim language, however, the examiner maintains that the claim is directed solely to that of the subcombination of the fastener and does not include a forming screw. Rather, the hollow bore of the prior art of DE 19609252 must only be capable of having a forming screw form a thread therein in order to be applicable. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Next, with regard to independent claim 30, while the claim is directed to a component assembly, the only two components within this assembly as recited in the preamble are those of the sheet metal part and the hollow fastener element; with the remaining aspects of the claim being dependent upon the hollow fastener element, "wherein the fastener element..." Thus, as

with claim 1, the instant claim does not positively require the thread forming or cutting screw, but rather, the hollow fastener element must only be capable of receiving a thread forming or cutting screw...and ultimately forming an electrically conductive connection. Again, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). To properly include other components within the assembly, the claim should be amended to include such components in the preamble, i.e., a component assembly consisting of a sheet metal part, a hollow fastener element, ***, and ***.

Conclusion

[4] THIS ACTION IS NON-FINAL

[5] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID REESE/
Examiner, Art Unit 3677